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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/075,596	02/15/2002	Bruce H. Hanson	FS-00655	9439

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EXAMINER

MILLER, JONATHAN R

ART UNIT	PAPER NUMBER
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3653

DATE MAILED: 11/19/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

10/075,596

Applicant(s)

HANSON ET AL.

Examiner

Jonathan R. Miller

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 19 August 2003.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-21 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 13, 14 and 16 is/are allowed.
- 6) ☒ Claim(s) 1-12, 15 and 17-21 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☒ The proposed drawing correction filed on 19 August 2003 is: a) ☒ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

## DETAILED ACTION

### *Claim Rejections - 35 USC § 112*

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claims 1 – 10 are rejected under 35 U.S.C. 112, second paragraph, as being incomplete for omitting essential elements, such omission amounting to a gap between the elements. See MPEP § 2172.01. The omitted elements are: optical edge recognition system. Without this element the apparatus cannot function. Applicant contends that this is not an essential feature for the invention to work. The Examiner disagrees. The invention sorts stacks of bound products by the location of the binding. This determination of the location of the binding is done by the optical edge recognition system. Without this system there is no way to determine the location of the bound edge.

3. Claims 9 and 10 recite the limitation "the stacks of products" in lines 2 and 3 respectively. There is insufficient antecedent basis for this limitation in the claim. More specifically, there is no antecedent basis to the center stack. Is "stacks of products" meant to include the center stack? This also causes the claims to be indefinite.

4. Claim 15 recites the limitation "the information received from the optical edge recognition system" in line 3. There is insufficient antecedent basis for this limitation in the claim. Additionally, the language "are designed to" in line 2, should be removed to avoid indefiniteness issues

5. Claims 17 – 20 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant

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regards as the invention. In claim 17, the phrase "detecting a difference between edges" is indefinite. Further, in claim 20, the phrase "wherein the detecting step is based in a difference in thickness between the edges" is indefinite. Is this a spatial difference (i.e. a measurement of length) between edges? Which edges?

6. Claims 17 – 20 are rejected under 35 U.S.C. 112, second paragraph, as being incomplete for omitting essential steps, such omission amounting to a gap between the steps. See MPEP § 2172.01. The omitted steps are: determining the position of the bound edge of the product. Applicant contends, "the recitation of 'bound' edges is not necessary." Examiner disagrees. The invention is based on the need to sort stacks of bound products into stacks so that their respective bindings are uniformly arranged in the completed stacks. Thus the independent claim must include a recitation of bound edges.

7. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

8. Claims 6 and 7 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. The Examiner cannot find a description in the specification that describes a "transportation mechanism is three belt driven transportation mechanisms".

*Claim Rejections - 35 USC § 102*

9. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

10. Claims 1 – 5, 8, 11 and 12 are rejected under 35 U.S.C. 102(b) as being anticipated by Borchert et al. The reference discloses a plurality of compartments (Fig. 1), a plurality of moveable plates associated with each of the plurality of compartments (as shown in Fig. 1, the plates for the central compartment are obviously shown and the plates for the side compartments are shown supporting the separated sheets – these are supported on springs and are moveable), and a stationary feed head mechanism positioned proximate a central compartment of the plurality of compartments (Fig. 1), the feed head mechanism being capable of transporting the products from the central compartment to remaining compartments of the plurality of compartments (col. 2, lines 1+), wherein the feed head mechanism allows the arrangement of products transported to the remaining compartments to be each stacked proximate the moveable plates (Fig. 1). Examiner contends that the phrase “oriented with bound edges in the homogeneous orientation” is intended use and is not afforded patentable weight.

11. With regards to claim 2, the reference further discloses the feed head mechanism separately transports each of the products from the central compartment to the remaining compartments (col. 2, lines 1+).

12. With regards to claim 3, the reference further discloses the central moveable plate supports the products (Fig. 1). Examiner contends that the phrase "which have bound edges oriented in opposing directions" is intended use and is not afforded patentable weight.

13. With regards to claim 4, the reference further discloses the plurality of compartments includes the central compartment and opposing side compartments (Fig. 1).

14. With regards to claim 5, the reference further discloses the feed head mechanism comprising a belt driven transportation mechanism having a plurality of suction ports and a vacuum source in communication with the plurality of suction ports (col. 2, lines 1+).

15. With regards to claim 8, the reference further discloses moveable walls separating each of the plurality of compartments. These walls are shown in Fig. 1. The center compartment has moveable walls that move up and down with the elevator. The walls of the outer compartments are shown attached to the plates, referenced above. These walls separate each of the compartments.

16. With regards to claim 11, the reference further discloses the feed head mechanism includes an optical edge recognition system (col. 1, lines 40+). Examiner contends that the phrase "for detecting a bound edge of the product" is intended use and is not afforded patentable weight.

17. With regards to claim 12, the reference further discloses that information is received from the optical edge recognition system is used for separately transporting products of the stack from the central compartment to the remaining compartments which are opposing side compartments (col. 1, lines 40+). Examiner contends that the phrase "thereby orienting the stack of products on each of the opposing side compartments with bound edges in the homogenous orientation" is intended use and is not afforded patentable weight.

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*Allowable Subject Matter*

18. Claims 13, 14 and 16 are allowed.


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jonathan R. Miller whose telephone number is (703) 305-5778.

The examiner can normally be reached on M-F: 8:30AM-5:00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Donald P. Walsh can be reached on (703) 306-4173. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1113.

jrm

  
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